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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,514	11/02/2000	Jeffry Jovan Philyaw	PHLY-25,509	6936
25883	7590	07/26/2005	EXAMINER	
HOWISON & ARNOTT, L.L.P			POLLACK, MELVIN H	
P.O. BOX 741715			ART UNIT	
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2145
DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/705,514

Applicant(s)

PHILYAW, JEFFRY JOVAN

Examiner

Melvin H. Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/16/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached office action.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/16/05 has been entered.

Response to Arguments

2. Applicant's arguments filed 5/16/05 have been fully considered but they are not persuasive. An analysis is provided below.

3. The examiner withdraws the 112 rejections in light of the amendment provided.

4. Stern provides a method and system (abstract) involving a server (Fig. 2, #26) and a set of kiosks (Fig. 2, #30c) in which the kiosks must be programmed not only with visual information but with instructions (col. 7, lines 55-60) regarding how to display the visual data and to set up input devices such as UPC scanners. For example, as shown in Fig. 4 regarding communications between the server (top half) and the store sites (Fig. 4, bottom half) the builder module (Fig. 4, #350) "analyzes the NMC database... to determine the advertisement and *control information* to be *included* in the distribution files 304... for distribution to multiple stores... (col. 9, lines 1-10; italics added for emphasis), based upon instructions from the distribution editor module (col. 8, lines 43-65). Script files include "advertising information, ... *control information* such as the order and sequence the aforementioned files..." and a list of UPC codes so that the UPC input device may compare the input to the UPC code file (col. 9, lines 49-60).

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Further, the site module 600 “interprets script files... The script file contains instructions that define the behavior and content of the Site module 500. The file is built at the NMC (Fig. 4, #252) by the Builder Module and transmitted along with each new distribution. It defines which previewable UPC titles will be available, which advertising and attract videos are to be played and in what order, as well as the behavior of the software to consumer commands from the Listening Post (col. 17, lines 10-50).”

5. The applicant claims that Stern does not expressly disclose “releasing a control signal that is a part of the broadcast and which control signal is in association with the visual cue.... (p. 6, lines 3-14).” As shown above, Stern teaches the sending of a visual cue (advertisement information) and control information (i.e. scripts to control the kiosk) that are associated with the visual information (i.e. scripts that tell the kiosk the order and time of showing advertisements) and control the computer (i.e. the kiosk runs the script) and the input device (i.e. scripts and files to program the UPC scanner module so that said input module will accept and understand UPC scan commands). Further, regarding the allegation that “the only control that is provided is by the user inputting a UPC to the computer,” if this were true, then a Stern kiosk would be inactive before a UPC scanning, which it is clearly not (col. 6, lines 35-50; a user sees the visual information and *then* scans a UPC code. Ergo, some other control must be used before the scanning process.). A similar analysis was provided in a prior office action.

6. For the reasons above, the rejection is maintained.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-7, 16-18, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Stern et al. (6,591,247).

9. For claim 1, Stern teaches a method (abstract) for facilitating computer based access (col. 1, line 30 – col. 4, line 30) to a location (Fig. 2, #30c) on a network (Fig. 1, #10) by a consumer witnessing a presentation broadcast to the consumer (col. 3, lines 50-55), comprising the steps of:

- a. Providing a visual cue during the presentation apparent to the consumer (col. 6, lines 35-45) and indicative of a relationship between the visual cue and the presence of the location on the network (col. 6, lines 45-60); and
- b. Releasing a control signal (col. 8, line 65 – col. 9, line 10) that is part of the broadcast (col. 9, lines 1-10) and which control signal is in association with the visual cue (col. 17, lines 10-50), the step of releasing occurring during the broadcast (Fig. 4, #450), and wherein a computer having an input device responsive to the control signal can be controlled (col. 9, lines 49-60) such that the control signal can both be recognized by the input device and control information contained in the control signal can be extracted therefrom (col. 17, lines 5-50) to enable and control the computer to access the location on the network upon the appearance of the visual cue and receipt of the control signal during the broadcast of the presentation, which control is facilitated from the broadcast with no user intervention (col. 9, lines 50-60).

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10. For claim 2, Stern teaches attracting the consumer's attention to the computer for interacting with the location on the network in association with the access thereto (col. 17, lines 5-10).

11. For claim 3, Stern teaches that the step of providing a visual cue precedes the step of releasing the control signal (col. 8, lines 50-65).

12. For claim 4, Stern teaches that the step of releasing the control signal precedes the step of providing a visual cue (col. 20, line 66 – col. 21, line 7).

13. For claim 5, Stern teaches that the steps of providing the visual cue and releasing the control signal occur simultaneously (col. 16, lines 10-20).

14. For claim 6, Stern teaches that the steps of providing the visual cue and releasing the control signal occur within a defined interval of time (col. 9, lines 55-60).

15. For claim 7, Stern teaches animating the visual cue during its appearance wherein the animation is accompanied by the control signal (col. 12, lines 34-36).

16. For claim 16, Stern teaches that the visual cue (col. 25, lines 33-40) includes a logo (bumper).

17. For claim 17, Stern teaches that the presentation witnessed by the consumer includes a program having audio and video content (col. 17, lines 25-40).

18. For claim 18, Stern teaches that the presentation witnessed by the consumer includes a broadcast communication having audio and video content (col. 25, lines 5-59).

19. For claim 20, Stern teaches that the presentation includes a recorded portion (col. 12, lines 20-25).

Claim Rejections - 35 USC § 103

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20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern as applied to claims 1, 7 above, and further in view of Portuesi (5,987,507).

22. For claim 8, Stern does not expressly disclose detaching one or more moving segments from a stationary portion of the visual cue, and traversing a path with each detached segment about the stationary portion of the visual cue to a predetermined position adjacent thereto.

Portuesi teaches a method (abstract) of displaying visual cues during a broadcast which may then be activated to assist in gaining remote information (col. 1, line 15 – col. 4, line 5) and in which this limitation is further taught (col. 6, lines 20-45). At the time the invention was made, one of ordinary skill in the art would have added the Portuesi input method to Stern in order to ensure easier selection of data (col. 3, lines 20-30).

23. For claim 9, Stern and Portuesi do not expressly disclose that the stationary portion of the visual cue forms an alphanumeric character and the moving segment resembles a punctuation mark. Examiner takes Official Notice (see MPEP § 2144.03) that the particular design of the visual cue mentioned above, in a computer networking environment, was well known in the art at the time the invention was made. That is, it has already been shown that a visual cue is made of a stationary picture and a moving picture, and the examiner concludes that it would be trivial and obvious to replace one picture with another. Furthermore, this particular display adds no functionality over a different type of display in which part of the system moves. At the time the

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invention was made, one of ordinary skill in the art would have used the aforementioned pictures for aesthetic design purposes.

24. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

25. For claim 10, Stern does not expressly disclose that the stationary portion of the visual cue forms an iconic figure and the moving segment resembles an element of said iconic figure. *Porteusi* teaches this limitation (Fig. 4, #40). At the time the invention was made, one of ordinary skill in the art would have added this separation to enable movement of visual cues (col. 3, lines 43-45).

26. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stern as applied to claim 1 above, and further in view of *Jensen et al.* (6,421,445).

27. For claim 11, Stern does not expressly disclose the step of releasing a control signal comprises providing an audible sound signal as a part of the broadcast having a recognizable characteristic that is identifiable each time it occurs by the input device on the computer, the sound signal comprising the control signal. *Jensen* teaches a method (see abstract) for a

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broadcast system (col. 1, lines 18-21) in which command signals are embedded in audio signals (col. 2, lines 6-9). At the time the invention was made, one of ordinary skill in the art would have used Jensen in a Stern system in order to fulfill a variety of broadcasting purposes, such as tracking of ratings (col. 31, lines 44-45) and commercials (col. 33, lines 25-30).

28. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stern as applied to claim 1 above, and further in view of Itoh et al. (6,487,719).

29. For claim 15, Portuesi does not expressly disclose the step of releasing a control signal comprises the step of providing a light signal having a recognizable characteristic that is identifiable each time it occurs by the input device on the computer, the light signal comprising the control signal. Itoh teaches a method (see abstract) in which a monitoring of a broadcast (col. 1, lines 5-15) is achieved through light control signals (col. 3, lines 27-54). At the time the invention was made, one of ordinary skill in the art would have used Itoh to perform channel monitoring (col. 3, lines 1-27).

30. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stern as applied to claim 1 above, and further in view of Ludwig et al. (6,237,025).

31. For claim 19, Stern does not expressly disclose that the presentation witnessed by the consumer includes a live presentation. Ludwig teaches a method (see abstract) of videoconferencing (col. 21, lines 45-55) in which active URLs may be embedded into the presentation (Fig. 30). At the time the invention was made, one of ordinary skill in the art would

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have combined the two inventions in order to allow real-time information to be transmitted (col. 4, lines 55-65).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
13 July 2005


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Primary EX
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